

DEC 01 2006

**Remarks**

The above Amendments and these Remarks are in reply to the Office Action mailed August 10, 2006.

Claims 1-36 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected claims 1-36. The present Reply contains evidence of the obligation of assignment under 35 U.S.C. §103(c) to overcome the 35 U.S.C. §103(a) rejection to claims 7-9, 17-19, 26-29, 35, and 36. Reconsideration of the rejections is requested.

**I. Summary of Examiner's Rejections**

Claims 1-6, 10-16, 20-25, and 29-34 were rejected under 35 U.S.C. §102(e) as being anticipated by Chan, et al. (US 2003/0028364).

Claims 7-9, 17-19, 26-29, 35 and 36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Chan in view of Zatloukal (U.S. Pat. No. 7,076,772).

**II. Response to Rejections**

The rejection to claims 7-9, 17-19, 26-29, 35, and 36 as being unpatentable over Chan in view of Zatloukal (U.S. Pat. No. 7,076,772) is overcome by 35 U.S.C. §103(c). "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." Both Zatloukal (U.S. Patent 7,076,772, priority date Feb. 26, 2003) and the current application by Zatloukal et al (priority date July 18, 2003) were subject to an obligation of assignment to the same person, BEA

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Systems, Inc.. Zatloukal (U.S. Patent 7,076,772) is a 35 U.S.C. §102(e) reference because the priority date is less than one year before the priority date of the current application by Zatloukal et al. The combination of Zatloukal and Chan (two 35 U.S.C. §102(e) references) under 35 U.S.C. §103(a) is overcome by 35 U.S.C. §103(c). Copies of the relevant Assignments are attached as evidence of the obligation of assignment under 35 U.S.C. §103(c) (see Appendix A).

III. Conclusion


In light of the above, it is respectfully submitted that claims 7-9, 17-19, 26-29, 35 and 36 should be allowable, and reconsideration is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. §1.136 for extending the time to respond up to and including December 10, 2006.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: December 1, 2006

By:   
Thomas K. Plunkett  
Reg. No. 57,253

Customer No. 23910  
FLIESLER MEYER LLP  
Four Embarcadero Center, Fourth Floor  
San Francisco, California 94111-4156  
Telephone: (415) 362-3800

## APPENDIX A

- 12 -

Attorney Docket No.: BEAS-01469US0  
tplunkett/beas/1469us0/1469us0.replyA.doc

PAGE 16/27 \* RCVD AT 12/1/2006 6:36:44 PM [Eastern Standard Time] \* SVR:USPTO-EFAXF-1/7 \* DNIS:2738300 \* CSID:415 362 2928 \* DURATION (mm-ss):07-20



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

AUGUST 20, 2004

FLIESLER MEYER LLP  
SHELDON R. MEYER  
4 EMBARCADERO CENTER  
4TH FLOOR  
SAN FRANCISCO, CA 94111

PTAS

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FLIESLER MEYER LLP

\*102680634A\*

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THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 02/19/2004 ✓

REEL/FRAME: 015010/0628 ✓

NUMBER OF PAGES: 3 ✓

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

ZATLOUKAL, KEVIN

DOC DATE: 02/17/2004 ✓

ASSIGNEE:

BEA SYSTEMS, INC. ✓  
2315 NORTH FIRST STREET  
SAN JOSE, CALIFORNIA 95131

SERIAL NUMBER: 10782715 ✓

FILING DATE: 02/19/2004 ✓

PATENT NUMBER:

ISSUE DATE:

TITLE: SYSTEM AND METHOD FOR MULTI-LANGUAGE EXTENSIBLE COMPILER FRAMEWORK ✓

Friesler Meyer LLP

File: BEA-01396US1

Action Item: \_\_\_\_\_

Date Due: \_\_\_\_\_

Critical Date: \_\_\_\_\_

Attorney Fee: 500/038/PTX

Docketed By: JCM

Verified By: mp1

015010/0628 PAGE 2

STEVEN POST, EXAMINER  
ASSIGNMENT DIVISION  
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<p>2-19-04 R 03-01-2004 T U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office</p> <p>Customer No. 23910</p>	
<p>To the Honorable Commissioner of Patents and Trademarks 102680634 original documents or copy thereof.</p>	
<p>1. Name of conveying party(ies): Kevin Zatloukal</p> <p>Additional name(s) of conveying party(ies) attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No</p>	<p>2. Name and address of receiving party(ies):</p> <p>Name: <u>BEA Systems, Inc.</u></p> <p>Address: <u>2315 North First Street</u> <u>San Jose, CA 95131</u></p> <p>Additional name(s) &amp; address(es) attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No</p>
<p>3. Nature of conveyance:</p> <p><input checked="" type="checkbox"/> Assignment <input type="checkbox"/> Merger <input type="checkbox"/> Security Agreement <input type="checkbox"/> Change of Name <input type="checkbox"/> Other</p> <p>Execution Date: <u>02/17/04</u></p>	<p>17497 U.S. PTO 10782715</p>
<p>4. Application number(s) or patent number(s):</p> <p>A. Parent Application No.: B. Confirmation No.: Title: <u>SYSTEM AND METHOD FOR MULTI- LANGUAGE EXTENSIBLE COMPILER FRAMEWORK</u></p> <p>Filed Date: <u>Herewith</u></p> <p>Additional numbers attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No</p> <p>If this document is being filed together with a new application, the execution date of the application is: <u>02/17/04</u></p>	<p>C. Patent No(s):</p> <p><u>10782715</u></p>
<p>5. Name and address of party to whom correspondence concerning document should be mailed:</p> <p>Name: <u>Sheldon R. Meyer</u></p> <p>Address: <u>Fliesler Meyer LLP</u> <u>Four Embarcadero Center, Fourth Floor</u> <u>San Francisco, CA 94111</u></p> <p>Telephone: <u>(415) 362-3800</u></p>	<p>6. Total Number of applications and patents involved: <u>1</u> X \$40.00 each</p> <p>7. Total fee (37 CFR 3.41).....\$ <u>40.00</u></p> <p><input checked="" type="checkbox"/> Check Enclosed</p> <p>8. Fee Authorization. Authorization is given to charge any additional fees or credit any overpayment to Deposit Account No. 06-1325. Copy. (A duplicate copy of this authorization is <u>not</u> enclosed.)</p>
<p>9. Statement and signature. <i>To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.</i></p> <p><u>Sheldon R. Meyer</u> <u>[Signature]</u> <u>2/19/04</u> Attorney (Reg. No.: <u>27,660</u>) Signature Date</p>	
<p>10. Total number of pages to be recorded, <u>3</u> (1-page cover sheet and <u>2</u>- page document).</p>	

Attorney Docket No.: BEAS-01396US1 SRM/DTX  
dxue/beas/1396us1/1396us1.assign cover.wpd

- 1 -

02/25/2004 14:00:00 10782715

04 FC-8021 40.00 DP

## SOLE TO CORPORATE ASSIGNMENT

WHEREAS, the undersigned, Kevin Zatloukal, a resident of Cambridge, Massachusetts, (hereinafter termed "Inventor"), has invented certain new and useful improvements in:

### SYSTEM AND METHOD FOR MULTI-LANGUAGE EXTENSIBLE COMPILER FRAMEWORK

and has executed a declaration or oath for an application for a United States patent disclosing and identifying the invention.

WHEREAS BEA Systems, Inc. (hereinafter termed "Assignee"), a corporation of the State of Delaware, having a place of business at 2315 North First Street, San Jose, 95131, State of California, wishes to acquire the entire right, title and interest in and to said application and the invention disclosed therein, and in and to all embodiments of the invention, heretofore conceived, made or discovered by said Inventor (all collectively hereinafter termed "said invention"), and in and to any and all patents, certificates of invention and other forms of protection thereon (hereinafter termed "patents") applied for or granted in the United States and/or other countries.

NOW THEREFORE, for good and valuable consideration acknowledged by said Inventor to have been received in full from said Assignee:

1. Said Inventor does hereby sell, assign, transfer and convey unto said Assignee, the entire right, title and interest (a) in and to said application and said invention; (b) in and to all rights to apply in any and all countries of the world for patents, certificates of inventions or other governmental grants on said invention, including the right to apply for patents pursuant to the International Convention for the Protection of Industrial Property or pursuant to any other convention, treaty, agreement or understanding; (c) in and to any and all applications filed and any and all patents, certificates of inventions or other governmental grants granted on said invention in the United States or any other country, including each and every application filed and each and every patent granted on any application which is a division, substitution, or continuation of any of said applications; (d) in and to each and every reissue or extension of any of said patents; and (e) in and to each and every patent claim resulting from a reexamination certificate for any and all of said patents.

2. Said Inventor hereby covenants and agrees to cooperate with said Assignee to enable said Assignee to enjoy to the fullest extent the right, title and interest herein conveyed in the United States and other countries. Such cooperation by said Inventor shall include prompt production of pertinent facts and documents, giving of testimony, executing of petitions, oaths, specifications, declarations or other papers, and other assistance all to the extent deemed necessary or desirable by said Assignee (a) for perfecting in said Assignee the right, title and interest herein conveyed; (b) for complying with any duty of disclosure; (c) for prosecuting any of said applications; (d) for filing and prosecuting substitute, divisional, continuing or additional applications covering said invention; (e) for filing and prosecuting applications for reissue of any of said patents; (f) for interference or other priority proceedings involving said invention; and (g) for legal proceedings involving said invention and any applications therefor and any patents granted thereon, including without limitation opposition proceedings, cancellation proceedings, priority contests, public use proceedings, reexamination proceedings, compulsory licensing proceedings, infringement actions and court actions; provided, however, that the expense incurred by said Inventor in providing such cooperation shall be paid for by said Assignee.

3. The terms and covenants of this Assignment shall inure to the benefit of said Assignee, its successors, assigns and other legal representatives, and shall be binding upon said Inventor, said Inventor's heirs, legal representatives and assigns.

4. Said Inventor hereby warrants and represents that said Inventor has not entered and will not enter into any assignment, contract, or understanding in conflict herewith.

IN WITNESS WHEREOF, the said Inventor has executed this instrument on the date as given below and delivered this instrument to said Assignee:

Feb. 17, 2004  
Date

Kevin C. Zatloukal  
(Inventor's Signature)  
Kevin Zatloukal

State of MASSACHUSETTS)

County of MIDDLESEX)

On FEB. 17, 2004 before me, MARIA T. SENSALA, NOTARY PUBLIC  
(name and title of officer)

personally appeared Kevin Zatloukal, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument and acknowledged to me that he/she executed the same in his authorized capacity, and that by his signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature Maria T. Sensala  
Maria T. Sensala  
Notary Public  
My Commission Expires:  
February 27, 2009

\*\*\*\*\*





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MAY 14 2004

FLIESLER MEYER LLP

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

MAY 07, 2004

PTAS

FLIESLER DUBB MEYER & LOVEJOY LLP  
SHELDON R. MEYER  
FOUR EMBARCADERO CENTER, FOURTH FLOOR  
SAN FRANCISCO, CA 94111



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RECORDATION DATE: 10/03/2003

REEL/FRAME: 014582/0403

NUMBER OF PAGES: 13

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

ZATLOUKAL, KEVIN

DOC DATE: 09/29/2003

ASSIGNOR:

WAGNER, TIM A.

DOC DATE: 09/29/2003

ASSIGNEE:

BEA SYSTEMS, INC.  
2315 NORTH FIRST STREET  
SAN JOSE, CALIFORNIA 95131

SERIAL NUMBER: 10678248

FILING DATE: 10/03/2003

PATENT NUMBER:

ISSUE DATE:

Fliesler, Meyer LLP  
File BEAS-014691USP  
Action Item: \_\_\_\_\_  
Date Due: \_\_\_\_\_  
Critical Date: \_\_\_\_\_  
Attorney Path: SRM/DJB  
Docketed By: mpy  
Verified By: \_\_\_\_\_

014582/0403 PAGE 2

VIOLET MCCOY, EXAMINER  
ASSIGNMENT DIVISION  
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DEC 01 2006

22278 U.S. PTO  
10/678248

10-16-2003  
102575980  
PATENT

ET

U.S. DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Customer No. 23910

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies): 10.3.03

Kevin Zatloukal and Dr. Tim A. Wagner

Additional name(s) of conveying party(ies) attached? Yes ☒ No

2. Name and address of receiving party(ies):

Name: BEA Systems, Inc.

Address: 2315 North First Street

San Jose, California 95131

Additional name(s) & address(es) attached? Yes ☒ No

3. Nature of conveyance:

☒ Assignment ☐ Merger  
☐ Security Agreement ☐ Change of Name  
☐ Other

Execution Date: September 29, 2003

4. Application number(s) or patent number(s):

A. Patent Application No.: Unassigned

B. Confirmation No.:

Title: System And Method For Performing Code Completion In An Integrated Development Environment

Filed Date: Herewith

C. Patent No(s):

Additional numbers attached? Yes ☒ No

If this document is being filed together with a new application, the execution date of the application is: October 3, 2003

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Sheldon R. Meyer

Address: Flicsler Dubb Meyer & Lovcioy LLP

Four Embarcadero Center, Fourth Floor

San Francisco, CA 94111

Telephone: (415) 362-3800

6. Total Number of applications and patents involved: 1 X \$40.00 each

7. Total fee (37 CFR 3.41).....\$ 40.00

☒ Check Enclosed

8. Fee Authorization. Authorization is given to charge any additional fees or credit any overpayment to Deposit Account No. 06-1325.

Copy. (A duplicate copy of this authorization is not enclosed.)

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Daniel J. Burns

Attorney (Reg. No.: 50,222)

Signature

10/3/03

Date

10. Total number of pages to be recorded: 7 (1 page cover sheet and 6 page document).

10/06/2003 EFLDRES 00000020 10678248

10/06/2003

40.00 00

Attorney Docket No.: BEAS-01469US0 SRM/DJB

djb/beas/

- 1 -

## JOINT TO CORPORATE ASSIGNMENT

WHEREAS, the undersigned Inventors:

- (1) Kevin Zatloukal  
a resident of Cambridge, Massachusetts 02139; and
- (2) Dr. Tim. A. Wagner  
a resident of Seattle, Washington 98121

have invented certain new and useful improvements in:

### SYSTEM AND METHOD FOR PERFORMING CODE COMPLETION IN AN INTEGRATED DEVELOPMENT ENVIRONMENT

for which we have executed a declaration for an application for a United States patent on or about the date of this Assignment.

WHEREAS BEA Systems, Inc. (hereinafter termed "Assignee"), a corporation of the State of Delaware, having a place of business at 2315 North First Street, San Jose, California 95131, wishes to acquire the entire right, title and interest in and to said application and the invention disclosed therein, and in and to all embodiments of the invention, heretofore conceived, made or discovered jointly or severally by said Inventors (all collectively hereinafter termed "said invention"), and in and to any and all patents, certificates of invention and other forms of protection thereon (hereinafter termed "patents") applied for or granted in the United States and/or other countries.

NOW THEREFORE, for good and valuable consideration acknowledged by each of said Inventors to have been received in full from said Assignee:

1. Said Inventors do hereby sell, assign, transfer and convey to said Assignee, the entire right, title and interest (a) in and to said application and said invention; (b) in and to all rights to apply in any or all countries of the world for patents, certificates of inventions or other governmental grants on said invention, including the right to apply for patents pursuant to the International Convention for the Protection of Industrial Property or pursuant to any other convention, treaty, agreement or understanding; (c) in and to any and all applications filed and any and all patents, certificates of inventions or other governmental grants granted on said invention in the United States or any other country, including each and every application filed and each and every patent granted on any application which is a division, substitution, or continuation of any of said applications; (d) in and to each and every reissue or extension of any of said patents; and (e) in and to each and every patent claim resulting from a reexamination certificate for any and all of said patents.

2. Said Inventors hereby jointly and severally covenant and agree to cooperate with said Assignee to enable said Assignee to enjoy to the fullest extent the right, title and interest herein conveyed in the United States and other countries. Such cooperation by said Inventors shall include prompt production of pertinent facts and documents, giving of testimony, executing of petitions, oaths, specifications, declarations or other papers, and other assistance all to the extent deemed necessary or desirable by said Assignee (a) for perfecting in said Assignee the right, title and interest herein conveyed; (b) for complying with any duty of disclosure; (c) for prosecuting any of said applications; (d) for filing and prosecuting substitute, divisional, continuing or additional applications covering said invention; (e) for filing and prosecuting applications for

reissue of any of said patents; (f) for interference or other priority proceedings involving said invention; and (g) for legal proceedings involving said invention and any applications therefor and any patents granted thereon, including without limitation opposition proceedings, cancellation proceedings, priority contests, public use proceedings, reexamination proceedings, compulsory licensing proceedings, infringement actions and court actions; provided, however, that the expense incurred by said Inventors in providing such cooperation shall be paid for by said Assignee.

3. The terms and covenants of this Assignment shall inure to the benefit of said Assignee, its successors, assigns and other legal representatives, and shall be binding upon said Inventors, their respective heirs, legal representatives and assigns.

4. Said Inventors hereby jointly and severally warrant and represent that they have not entered and will not enter into any assignment, contract, or understanding in conflict herewith.

IN WITNESS WHEREOF, the said Inventors have executed this instrument on the date as given below and delivered this instrument to said Assignee:

September 29, 2003  
Date

(1) Kevin C. Zatloukal  
Kevin Zatloukal

State of Massachusetts

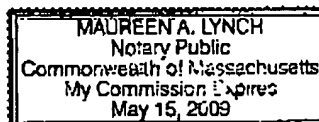
County of Suffolk

On Sept. 29, 2003 before me, Maureen Lynch  
(name and title of officer)

personally appeared K. Zatloukal, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person(s) whose name(s) is/are subscribed to the within instrument and acknowledged to me that he/she/they executed the same in his/her/their authorized capacity(ies), and that by his/her/their signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal.

Signature Maureen A. Lynch



\*\*\*\*\*

Date \_\_\_\_\_

(2)

Tim A. Wagner  
Dr. Tim A. Wagner

State of \_\_\_\_\_ )

County of \_\_\_\_\_ )

On \_\_\_\_\_ before me, \_\_\_\_\_  
(name and title of officer)

personally appeared \_\_\_\_\_, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person(s) whose name(s) is/are subscribed to the within instrument and acknowledged to me that he/she/they executed the same in his/her/their authorized capacity(ies), and that by his/her/their signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal.

Signature \_\_\_\_\_

\*\*\*\*\*